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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,518	01/26/2001	Pierre Messier	CLW 2 0142	5871
24964	7590	09/09/2004	EXAMINER	
GOODWIN PROCTER L.L.P			CHORBAJI, MONZER R	
103 EISENHOWER PARKWAY			ART UNIT	
ROSELAND, NJ 07068			PAPER NUMBER	

1744

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/770,518	Applicant(s) MESSIER ET AL.	
	Examiner MONZER R CHORBAJI	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003 and 17 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This final office action is in response to the amendments received on 12/22/03 and 06/17/04

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smyth et al (U.S.P.N. 5,916,568) in view of Mattila et al (U.S.P.N. 6,049,002) and further in view Petri (EP 0 842 605 A1).

With respect to claims 28 and 32, the ('568) reference discloses a flash dry disinfectant composition (col.1, lines 40-42), which is intrinsically contained in an apparatus for dispensing applications onto surfaces (col.3, lines 35-39). Regarding the concentration ranges of the components of the composition, the ('568) reference discloses the following: 15% to about 35% by weight hydrogen peroxide (col.2, lines 38-39), 48% to about 78% by weight flash vaporization component (col.2, lines 37-38) and up to 30% by weight water (col.2, lines 59-60). The ('568) reference further teaches that the amount of hydrogen peroxide in the aqueous hydrogen peroxide solution should be at least 9% (col.2, lines 12-14) and specifically teaches the benefit of increasing the weight percent of hydrogen peroxide in the solution so that the effective rapid antimicrobial effect is insured. However, the ('568) reference fails to disclose a 10-30% by volume of hydrogen peroxide and an aerosol composition dispensed from an aerosol spray apparatus. The ('002) reference, which in the art of preparing disinfectant compositions (col.4, lines 41-44), teaches adding 30% by weight or 20% by volume (col.3, lines 55-57) of hydrogen peroxide to 98% by weight formic acid. In calculating the 20% by volume hydrogen peroxide, the table on page 10 of the amendment received on 12/22/2003 was used along with the density of formic acid. As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the flash dry disinfectant composition of the ('568) reference by increasing the

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amount of the hydrogen peroxide present in the hydrogen peroxide solution in order to prepare a composition for sterilization, sanitization and disinfection purposes as taught by the ('002) reference (col.4, lines 41-42).

However, with respect to dispensing an aerosol composition using an aerosol spray apparatus, the ('002) reference fails to disclose such a limitation. The ('605) reference teaches a sprayer for dispensing an anti-microbial composition (page 9, lines 37-40). Further on the ('002) reference teaches the formation of mist as the composition is sprayed onto a surface (page 5, lines 15-17). The word mist is synonymous with aerosol as disclosed by the Webster's dictionary on page 19. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the ('568) reference to include an aerosol sprayer since sprayers allow to uniformly apply to a relatively large area of a surface to be disinfected the liquid compositions as taught by the ('605) reference (page 9, lines 40-43).

With respect to claims 29 and 33, the ('568) reference discloses an alkanol as the flash dry vaporization component (col.3, the example).

With respect to claims 30 and 34, the ('568) reference discloses hydrogen peroxide as the anti-microbial agent (col.3, the example).

With respect to claims 31 and 35, the ('568) reference teaches that it is known to use ethanol as the flash dry vaporization component (col.1, lines 21-25).

Response to Arguments

5. Applicant's arguments filed on 12/22/2003 have been fully considered but they are not persuasive.

On page 9 of the response, applicant argues, "Smyth's hydrogen peroxide solution further comprises at least 9% by weight of hydrogen peroxide". On page 5 of the specification, the applicant teaches using 30% by volume hydrogen peroxide and 70% percent water. Also, pages 11, 14-20 of the specification, disclose 10% or 20% or 30% by volume hydrogen peroxide. It is not clear whether the concentration ranges for the hydrogen peroxide disclosed in claims 28 and 32 refer to 10 or 20 or 30% by volume. However, the ('002) reference is combined to show that using 30 % by weight or 20% by volume hydrogen peroxide is known in the art of preparing disinfecting solutions. Also, the ('568) reference explicitly teaches that the concentration of hydrogen peroxide in the hydrogen peroxide solution should be at least 9% by weight and goes further to provide the benefit of increasing the amount of hydrogen peroxide in the solution in order to insure effective rapid antimicrobial effect (col.2, lines 12-13).

On page 9 of the response, applicant argues, "Smyth does not disclose a flash-dry disinfectant composition". The examiner disagrees. On pages 4-5 of the specification, the applicant defines a flash-dry disinfectant that is able to achieve in a relatively short period of time after applying the flash dry aerosol to a surface, a state wherein the surface is essentially dry leaving behind the antimicrobial agent. The ('568) reference teaches such a limitation. For example in col.2, lines 9-10 and lines 41-42, such that the ('568) reference recognizes the need for fast drying by using isopropanol instead of other alcohols.

On page 10 of the response, applicant argues, "Petri does not disclose an aerosol apparatus." The examiner disagrees. On page 5, lines 14-17, the ('605)

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reference explicitly teaches that the addition of the shear thinning polymeric thickener allows the formation of mist as it is sprayed onto a surface. The word mist is synonymous with aerosol as disclosed by the Webster's dictionary on page 19. Thus, the ('605) reference does teach an aerosol apparatus that sprays a disinfectant composition in aerosol form.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONZER R CHORBAJI whose telephone number is (571) 272-1271. The examiner can normally be reached on M-F 6:30-3:00.

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9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT J WARDEN can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monzer R. Chorbaji *MRC*
Patent Examiner
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08/31/2004

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